

REMARKS

The last Office Action has been carefully considered.

It is noted that claims 1, 3, 4, and 6-13 are rejected under 35 U.S.C. 102(b) over the German patent document DE '011.

Also, the claims are rejected under 35 U.S.C. 112.

In connection with the Examiner's rejection of the claims for formal reasons under 35 U.S.C. 112, applicants have canceled claims 2, 8 and 9 and it is therefore believed that the features of these claims do not have to be illustrated.

As for claim 5, the specification explains in detail that the outlet pipe which surrounds the outlet is formed turnable so that the operator can individually adjust the air discharge device as convenient to him or as necessary for the work applications, as explained in paragraph 4 on page 11. The turning of the pipe can be achieved by any known means, and it is believed that they are conventional and should not be illustrated.

After carefully considering the Examiner's grounds for the rejection of the claims over the art, applicants have amended claim 1, the broadest claim on file, so as to more clearly define the present invention and to distinguish it from the prior art.

Claim 1 as amended specifically defines that the electric hand power tool in accordance with the present invention has a motor housing 10 which accommodates an air-cooled electric motor, a tool 15 which is driven by the electric motor, a handle 11 and an auxiliary handle 21 provided in the housing for a two-hand guidance of the hand power tool, with the auxiliary handle 21 positioned in a plane transverse to the plane of the first handle 11 and, with reference to the work direction, before the handle 11. In the inventive electric hand power tool the auxiliary handle 21 is completely hollow and carries motor cooling air which has left the motor housing 10 after having passed a protective hood 15 for the tool 15, and the auxiliary handle 21 is operative for damping the flow noise of the motor cooling air.

Turning now to the reference and particularly to the German patent document DE '011, it can be seen that this reference discloses a hand power tool with a housing, a motor, a tool driven by the motor, and handles for two-hand guidance. However, this reference does not disclose the new features of the present invention which are now defined in claim 11, in

particular it does not disclose such an electric hand power tool in which the auxiliary handle is completely hollow and carries motor cooling air which left the motor housing and passed a protective hood for a tool, so that the auxiliary handle serves for damping the flow noise of the air.

The original claims were rejected over this reference as being anticipated. As explained herein above, the reference does not disclose the new features of the present invention which are now defined in claim 11, in particular the specific structure for carrying motor-cooling air which provides damping or silencing of the flow noise of the air. In connection with this, it is believed to be advisable to cite the decision in *re Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 221 USPQ 481, 485 (Fed. Cir. 1984) in which it was stated:

"Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim."

Definitely, the reference does not disclose a device which contains each and every element of the electric hand power tool defined now in claim 1. Therefore it is believed that the anticipation rejection should be considered as no longer tenable with respect to the amended claim 1, and should be withdrawn.

As explained herein above, the present invention provides for the highly advantageous results in damping or silencing a flow noise of the motor cooling air. These highly advantageous results are not accomplished in the construction disclosed in the reference. It is known that in order to arrive at a claimed invention, by modifying the references the cited art must itself contain a suggestion for such a modification. This principle has been consistently upheld by the U.S. Court of Customs and Patent Appeals which, for example, held in its decision in re Randol and Redford (165 USPQ 586) that

Prior patents are references only for what they clearly disclose or suggest; it is not a proper use of a patent as a reference to modify its structure to one which prior art references do not suggest.

In view of the above presented remarks and amendments, it is believed that claim 1 as amended should be considered as patentably distinguishing over the art and should be allowed.

As for the dependent claims, these claims depend on claim 1, they share its presumably allowable features, and therefore it is respectfully submitted that they should be allowed as well.

Reconsideration and allowance of the present application is most respectfully requested.

Should the Examiner require or consider it advisable that the specification, claims and/or drawings be further amended or corrected in formal respects in order to place this case in condition for final allowance, then it is respectfully requested that such amendments or corrections be carried out by Examiner's Amendment, and the case be passed to issue. Alternatively, should the Examiner feel that a personal discussion might be helpful in advancing this case to allowance, he is invited to telephone the undersigned (at 631-549-4700).

Respectfully submitted,



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